

REMARKS

A petition for a three month extension of time under 37 C.F.R. §1.136(a) is submitted herewith. This reply is therefore timely.

Claims 1-24 are currently pending. The Examiner objected to the drawings under 37 C.F.R. § 1.83(a). The Examiner rejected claims 1-23 under 35 U.S.C. § 101. The Examiner rejected claims 1-4, 6, 21, and 22 under 35 U.S.C. § 112, first paragraph. The Examiner rejected claims 10, 13, and 16 under 35 U.S.C. § 112, second paragraph. The Examiner rejected claim 24 as anticipated by U.S. Patent No. 2,674,813 (“Hutchinson”). The Examiner rejected claims 1-23 as obvious under 35 U.S.C. § 103(a) in light of U.S. Patent No. 5,118,171 (“Ortiz”). The Examiner rejected claims 1-23 as obvious under 35 U.S.C. § 103(a) in light of Hutchinson. These objections and rejections will be addressed in turn.

1. Drawings

The Examiner noted that 37 C.F.R. § 1.83(a) requires that the drawings show “every feature” of the invention specified in the claims. The Examiner then asserted that the drawings must illustrate a table, a chest, a historic landmark being a battlefield, a city, and a natural landmark, etc. The applicant respectfully disagrees. The invention has an infinite number of variations or embodiments. Not every variation or embodiment need be illustrated, merely one variation of each feature.

All of the claims require a piece of “furniture”. Some require a “cabinet”. The applicant believes that figure 2 illustrates a piece of furniture that is a cabinet. Webster’s New World Dictionary (Second College Edition 1972) defines “cabinet” as “a case or

cupboard with drawers or shelves for holding or storing things” (first definition, examples omitted). Figure 2 illustrates just such a case with shelves.

Similarly, with respect to claim 7, the drawings illustrate the feature of a “historic landmark” and in particular, one embodiment that falls within the terms of claim 7, namely a “historic building”.

2. Section 101

The examiner rejected claims 1-23 on the grounds that the inclusion of the “souvenir substance” in the claims renders the invention directed to non-statutory subject matter because the souvenir substance is a living or natural item. The applicant respectfully disagrees. While the applicant agrees that any particular souvenir substance itself cannot be patented, the applicant believes that the inclusion of the souvenir substance in the claim does not render it unpatentable.

It is not the any particular souvenir substance substance that the applicant seeks to patent, but rather the composite of all of the limitations of the claims, taken together. The applicant know of no authority that one cannot use a natural material in a patented invention.

3. Claim Rejections under 35 U.S.C. §112, First Paragraph

The Examiner rejected claim 1 on the grounds that the souvenir substance is not shown or described with enough detail so that one skilled in the art could ascertain how it is connected to the article of furniture. The applicant respectfully disagrees and asserts

that anyone skilled in the art inspecting figure 2 could easily deduce how to attach any souvenir substance to the article of furniture.

The Examiner rejected claims 2 and 3 on the grounds that a cover is not described in the specification as being attached to the horizontal shelf or being transparent. The applicant respectfully submits that in some embodiments of the present invention, a door can be a transparent cover and such door can be attached to the horizontal shelf.

The Examiner rejected claim 4 on the grounds that the disclosure does not show how a table or chest would have the horizontal shelf connected. The applicant respectfully asserts that it would be obvious to one skilled in the art how to connect the horizontal shelf to a table or chest in connection with the present invention.

The Examiner rejected claim 6 on the grounds that the horizontal shelf is not disclosed as being located on the upper surface of the article of furniture. On the contrary, such location was disclosed. See page 3, first full paragraph. One skilled in the art would understand such paragraph to include disclosing locating the horizontal shelf on the upper surface of the article of furniture.

The Examiner rejected claims 21 and 22 on the grounds that it was unclear how a scale model could be attached to the horizontal shelf or how it would fit inside the door. The applicant respectfully asserts that such matters would have been obvious to one skilled in the art. With respect to fitting inside the door, clearly, the scale model would be no larger than the available space.

4. Claim Rejections under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 10, 13, and 16 on the grounds that the use of the word “related” rendered the claims indefinite. The applicant respectfully disagrees. While in some circumstances items can indeed be related in many ways, famous people, for example, can only be related to famous landmarks in a rather straightforward manner. Benjamin Franklin is related to Independence Hall, Karl Marx is not.

5. Claim Rejections under 35 U.S.C. § 102

The Examiner rejected claim 24 as anticipated by Hutchinson. Claim 24 is “A cabinet” Hutchinson does not suggest or disclose a cabinet. Hutchinson’s invention is in fact incompatible with cabinets as it is a “Relief Map Historical Game or Toy” having interfitting sections. See Hutchinson, col. 1, line 1 to col. 2, line 21.

6. Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-23 as obvious in light of Ortiz. Claims 1-23 include the limitation “a visual representation of a historic landmark attached to said horizontal shelf”. Ortiz does not suggest or disclose any such visual representation of a historic landmark. While the Examiner suggests that it is proper to take official notice that representations of Independence Hall, for example, are well known, the applicant respectfully submits that use of visual representations of historic landmarks in

combination with the other limitations of the claims of the present application are not well known and that it is impermissible hindsight to assert without the benefit of a reference that the limitations of the claims are well known.

Ortiz shows, at most, that it is well known to combine multiple souvenir substances in a single display case.

The Examiner also rejected claims 1-23 as obvious in light of Hutchinson. Claims 1-23 include the limitation "a souvenir substance attached to the article of furniture". Hutchinson does not suggest or disclose a souvenir substance. While the Examiner suggests that it is proper to take official notice that souvenir substances are well known, the applicant respectfully submits that use of souvenir substances in combination with the other limitations of the claims of the present application are not well known and that it is impermissible hindsight to assert without the benefit of a reference that the limitations of the claims are well known.

For the above reasons, the applicant believes that claims 1-24 are allowable over the prior art of record and requests that a timely Notice of Allowance be issued.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Ethan D. Civan", written over a horizontal line.

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